

R E M A R K S

By the above-identified office action, the independent claims 1, 5, 10, 14, 15 and 17, and the dependent claims 2-4, 6-9, 11, 12, and 16-19, were rejected as a group under 35 USC 103 (a) as being unpatentable over Marsona 1250 in view of Kramer (W0 83/01705) and Severson et al. (USP 5,633,985). Marsona 1250 was cited for a digital sound relaxation system having a sound selection means, built-in memory and processor coupled to the memory and sound selection means operative to play any sound selected, but it was noted that Marsona does not show "a collectible sound card in [sic] associated with the device and a controller which can enable the device to repetitively replay sounds without disrupting pauses." Kramer was cited for teaching that it is "well known in the art to to [sic] provide a system which can provide extra sound entertainment from a collectible sound card; see page 3. Thus it would have been obvious for one skilled in the art at the time the invention was made to apply the teachings of Kramer to the device of Marsona so that more different choices of sound signals could have been accessed by the users." Severson et al. was cited for "sound systems [that] can provide non-disrupting sound signals; see: col. 1 lines 32-44. Thus it would have been obvious to apply the teachings of Severson to the modified device of Marsona so that listeners could have been continuously entertained without any annoying disruption." By the instant amendment, the independent claims 1, 5, 10, and 17 have been amended to better define the invention and to further patentably distinguish the instant invention from the prior art of record, and now call for a controller operative in built-in and sound

card sounds replay modes. Independent claim 10 has also been amended to recite that at least some of the sounds of the sound card are different from the built-in sounds. Claim 17 has also been amended in one instance to reflect proper syntax. No new matter has been entered.

In one of its inventive aspects, the claimed combinations as a whole of the independent claim 1 as now amended and independent claim 14 call for, among other things, a collectible sound card, and a digital sound relaxation and noise masking device operable in built-in and sound card replay modes, cooperative therewith, to make the sounds of the collectible sound card available for replay by the sound controller thereof in addition to the built-in sounds of the digital sound relaxation and noise masking device; these claims and their dependents are intended to protect against potential infringers who make, use or sell both collectible sound cards and cooperative digital sound relaxation systems in accord with the present invention.

In another of its inventive aspects, the claimed combinations as a whole of the independent claim 5 as now amended and independent claim 15 call for, among other things, a digital sound relaxation and noise masking device operable in built-in and sound card replay modes adapted to mate with a collectible sound card and operative to play prerecorded sounds built-in with the digital sound relaxation and noise masking device in built-in sound replay mode and/or sounds on the collectible sound card in sound card replay mode; these claims and their dependents are intended to protect against potential infringers who make, use or sell digital sound relaxation and noise masking systems adapted to mate with collectible sound cards but not the collectible sound cards themselves in accord with the present invention.

In another of its inventive aspects, the claimed combinations as a whole of the independent claims 10 and 17 as now amended call for, among other things, a collectible sound card having plural prerecorded sounds adapted for use with a digital sound relaxation and noise masking device operable in built-in and sound card sounds replay modes to play prerecorded built-in and/or sound card sounds, to make its sounds available for replay by the digital sound relaxation and noise masking device in sound card replay mode in addition to the built-in sounds in built-in sound replay mode; these claims and their dependents are intended to protect against potential infringers who make, use or sell collectible sound cards in accord with the present invention but not their cooperative digital sound relaxation and noise masking devices.

1. The Rejection of Record Does Not Disclose What it Is Relied upon to Render *Prima Facie* Obvious

The rejection of record misconstrues the Marsona 1250 and Kramer references, attributing to the Marsona 1250 device the lack of a feature that it in fact possesses, while attributing to the Kramer reference a feature that it in fact lacks.

The Marsona 1250 device plays one of ten built-in prerecorded sounds continuously and without disrupting pauses upon sequential depression of a sound select key. For example, upon first depression of the sound select key, the surf S1 sound is replayed continually, and without disrupting pauses, while subsequent depression thereof effects play of another of the ten built-in prerecorded sounds thereof.

Inasmuch as the Marsona 1250 device was cited as not showing "a controller which can enable the device to repetitively replay sounds without disrupting pauses," which feature it in fact possesses, it is respectfully submitted the rejection of record should for this reason alone be reconsidered and withdrawn.

Since Severson et al. was only cited for a feature erroneously thought to be absent from the Marsona 1250 reference, and because Marsona in fact possesses that feature, it is respectfully submitted the rejection of record for this further reason alone should be reconsidered and withdrawn and that further discussion of the Severson et al. reference is thereby rendered moot.

Kramer discloses a portable data processing and storage card (Figure 1) and cooperative input recorder (not shown) and sound replay unit (Figure 2), operative in write mode to digitally store a music track (or other sound piece) on the digital processing and storage card when connected to the input recorder, and operative in read mode to play the stored music track on the sound replay unit when the card is connected to the sound replay unit.

The digital processing and storage card includes input and output ports respectively couplable to the input recorder and sound replay unit, a bubble memory, and D/A decoders. A controller is coupled to the I/O ports, the D/A decoders and the bubble memory that is operative in write mode to store data and control information in the bubble memory when the card is connected to the input recorder via the input port, and that is operative in read mode to output the music and control data stored in the bubble memory when the card is connected to the sound replay unit via the output port.

The portable data processing and storage card in write mode is reprogrammable when connected to the input recorder like a cassette tape that is re-recordable in a cassette player, which enables a different sound to be stored thereon for subsequent replay in the sound replay unit thereof. And like a gramophone record whose sounds may be replayed on a record player, the sound stored on the portable data processing and storage card when it is in read mode may be replayed on the sound replay unit when connected to the sound replay unit.

There can only be the disclosure of a system which can provide "extra" sound entertainment from a collectible sound card if the alleged sound reproduction system is already capable of playing at least one built-in sound with respect to which the added sounds of the alleged collectible sound card may properly be said to be "extra." But if the sound system in question cannot already play some sounds, but is only capable of playing the sounds of the added sounds, the added sounds are the only sounds that the sound system plays -- but then they are in no sense "extra." And this is indeed the case with respect to the Kramer reference.

For just as a cassette tape/recorder and a gramophone record/record player do not teach or suggest systems which can provide extra sound entertainment respectively from a cassette or record, but only reproduce their sounds without which there simply are no sounds to play, the digital processing and storage card and associated sound replay unit of Kramer, which is functionally equivalent to a cassette tape/recorder or a gramophone record/record player system, does not teach or suggest "a system which can provide extra sound entertainment from a collectible sound card."

Since Kramer does not in fact disclose what it is relied upon to render *prima facie* obvious, namely, "a system which can provide extra sound entertainment from a collectible sound card," it is respectfully submitted that the rejection of record for this additional reason alone should be reconsidered and withdrawn.

2. There Is No Objective Reason, Either Explicit or Implicit, That Would Motivate One Skilled in the Art to Combine the Marsona 1250 and Kramer References to Provide the Inventive Aspects of the Claimed Combinations as a Whole of the Independent Claims of the Instant Invention.

The Marsona 1250 device is a digital sound relaxation and noise masking system that has a fixed library of ten prerecorded sounds available for selection. If the user of the Marsona 1250 device does not find a sound among those ten sounds available for play, or if the user grew tired of the same sounds, or if they lost their power to calm and soothe, the user of that device would have no choice but to undergo the trouble and expense of acquiring another digital sound relaxation and noise masking system that did have the sought for sound(s), or forego the potential noise masking and soothing benefits that may be derived from the new and different sound(s).

The Kramer reference discloses a portable data processing and storage card and sound replay unit that, apart from using a readily reprogrammable bubble memory to digitally store a tract of music or other analog signal in the place of tape or vinyl, essentially operates like a cassette/cassette recorder or record/record player to reproduce its sound tracks.

The prior art devices of the combination rejection of record therefore operate in different ways to achieve unrelated ends from which no motivation in fact can be found to combine them.

"The mere fact that the prior art could be modified in the manner proposed by the examiner would not have made the modification obvious unless the prior art suggested the desirability of the modification." Ex parte Dussand, 7 USPQ2d 1818, 1820 (Bd. Pat. App. & Int'f. 1988). As above discussed, however, since Marsona 1250 only plays built-in sounds to soothe the listener while Kramer only digitally emulates with its card the sound replay capability of cassette tapes or gramophone records on its sound replay unit, no such suggestion is or can be found from the prior art of the combination rejection of record.

Since there is no objective reason, either explicit or implicit, that would motive one of skill in the art to combine the Marsona 1250 sound relaxation system with Kramer's memory card to provide the inventive features of the claimed combinations as a whole of the independent claims of the present invention but only impermissible hindsight, the combination rejection of record is respectfully traversed for this further reason alone and its reconsideration and withdrawal are accordingly respectfully requested.

3. The Inventive Aspects of the Claimed Combinations as a Whole of the Independent Claims Are Patentably Distinct From the Prior Art References Applied

Because Kramer's card only digitally emulates the sound replay capability of cassette tapes or gramophone records on its sound replay unit, while Marsona 1250 only plays built-in sounds to soothe the listener, the combination does not teach or suggest, among other things, the recited collectible sound card and the recited cooperative digital sound relaxation system sound controller

operable to play sound card and/or built-in sounds respectively in the recited sound card and built-in sound replay modes of the inventive aspects of the claimed combinations as a whole of the independent claims 1 and 14 of the instant invention; does not teach or suggest, among other things, the recited digital sound relaxation and noise masking system sound controller operable in sound card and built-in sounds replay modes adapted to mate with a collectible sound card and operative to play prerecorded sounds built-in with the digital sound relaxation and noise masking device and/or sounds on the collectible sound card respectively in the recited stand-alone and sound-card modes of the inventive aspects of the claimed combinations as a whole of the independent claims 5 and 15 of the instant invention; and does not teach or suggest, among other things, the recited collectible sound card having plural prerecorded sounds adapted for use with the recited digital sound relaxation and noise masking device operable in built-in and sound card sound replay modes to make its sounds available for replay by the digital sound relaxation and noise masking device sound controller in addition to its built-in sounds of the inventive aspects of the claimed combinations as a whole of the independent claims 10 and 17 of the instant invention.

Secondary Considerations of Non-Obviousness--Commercial Success

Enclosed herewith is a copy of the declaration of Mr. Troy Anderson, which is believed to establish a nexus between the inventive aspects of the claimed combinations as a whole of the above-captioned invention and the commercial success of products embodying the present invention, and is hereby resubmitted as secondary considerations of the non-obviousness of the

present invention (it was originally submitted as part of the CPA application and Preliminary Amendment filed 12/17/1998).

As evidenced by paragraph 1 thereof, Mr. Anderson has a masters degree in business, is a co-inventor of the above-captioned invention, and is Vice President of Headwaters Research & Development, Inc., the owner of the above-captioned invention.

As evidenced by paragraph 2 thereof, as Vice President of Headwaters Research & Development, Inc., among other things, he is responsible for selling and marketing new products for world markets and for evaluating consumer responses to the products developed in order to monitor product acceptance and insure present and future consumer satisfaction.

As evidenced by paragraph 3 thereof, digital sound relaxation and noise masking devices represent a unique category of consumer products that are designed to alleviate stress and to promote a state of relaxation and calm.

As evidenced by paragraph 4 thereof, these devices simulate a natural or other sound environment that masks noise and soothes the listener without disrupting pauses.

As evidenced by paragraph 5 thereof, due to stress and noise not uncommon in modern Western societies, there is a considerable need for such devices.

As evidenced by paragraph 6 thereof, the present United States market for such devices is estimated at about 60 million dollars annually, which is expected to grow at a per annum rate of about 30 percent.

As evidenced by paragraph 7 thereof, the above-captioned invention is drawn to improved-customizability digital sound relaxation and noise masking devices that permit customers to customize the library of available sounds to their individual tastes and personal preferences by collecting collectible sound cards.

As evidenced by paragraph 8 thereof, in one of its inventive aspects, the claimed combinations as a whole of the independent claims 1 and 14 of the above-captioned invention call for, among other things, a collectible sound card, and a digital sound relaxation and noise masking device, cooperative therewith, in another of its inventive aspects, the claimed combinations as a whole of the independent claims 5 and 15 call for, among other things, a digital sound relaxation and noise masking device adapted to mate with a collectible sound card, and in another of its inventive aspects, the claimed combinations as a whole of the independent claims 10 and 17 call for, among other things, a collectible sound card for use with a digital sound relaxation and noise masking device.

As evidenced by paragraph 9 thereof, Headwaters Research & Development, Inc. and its affiliates ("Headwaters") currently markets four (4) collectible sound cards as detailed in Attachment "A" thereto.

As evidenced by paragraph 10 thereof, Headwaters sells under its Tranquil Moments® marks a line of commercially successful improved-customizability digital sound relaxation and noise masking devices in accord with the above-captioned invention, which have received consumer acceptance to the amount of about 10 million dollars per annum, which is about 17

percent of the estimated present annual United States market for digital sound relaxation and noise masking devices.

As evidenced by paragraph 11 thereof, Headwaters includes an owner's reply card with each improved-customizability digital sound relaxation and noise masking device in accord with the above-captioned invention sold under the Tranquil Moments® marks, and compiles information from those that are returned as well as from sales and other data.

As evidenced by paragraph 12 thereof, consumer feedback to the Tranquil Moments® products has indicated the first importance of sound variety to owners of improved-customizability digital sound relaxation and noise masking systems of the embodiment of Figures 1-7 in accord with the present invention as detailed in Attachment "B" thereto, which shows a bar chart compiled from 228 owner's reply cards from the years 1996-1997.

As evidenced by paragraph 13 thereof, the first importance of sound variety is believed on the one hand to be due to owner's different tastes in sounds. For example, one owner of a digital sound relaxation and noise masking device may prefer the sound of Rain Falling on a Tin Roof because it reminds them of similar cozy, rainy nights as a child, while another owner may prefer the sounds of Ocean Surf with Seagulls, because it reminds them of their of their favorite Hawaiian vacation. Since the heretofore known digital sound relaxation and noise masking devices only included a limited selection of built-in sounds, the collectible sound cards of the improved-customizability digital sound relaxation and noise masking devices of the present invention provide

customers with an expanded selection of sounds from which to choose, thereby increasing the probability that owners can find their ideal sound(s).

As evidenced by paragraph 14 thereof, the first importance of sound variety is believed on the other hand to be due to owner's different use situations and different moods. It is known that a large percentage of digital sound relaxation and noise masking device owners alternate between available sounds. Some do this for variety, others do it to suit different use situations or moods. For example, some owners may prefer a good noise blocking sound like a Waterfall for use at the office, while at home they may prefer the gentler Rain sound for relaxation. The collectible sound cards of the improved-customizability digital sound relaxation and noise masking devices in accord with the present invention provide a much larger repertoire from which users can find satisfactory sounds to fit the usage situation and prevailing mood.

As evidenced by paragraph 15 thereof, both to accommodate individual user's different tastes in sounds and to accommodate different use situations and changing moods, the inventive aspects of the claimed combinations as a whole in accord with the improved-customizability digital sound relaxation and noise masking devices of the present invention help satisfy what consumer response has indicated as the first importance of sound variety to owner's of digital sound relaxation and noise masking devices.

As evidenced by paragraph 16 thereof, five (5) representative owner's reply cards attached as Attachment "C" thereto detail the general importance of digital sound relaxation and noise masking devices to individual owners of improved-customizability digital sound relaxation and

noise masking devices in accord with the present invention, and five (5) representative owner's reply cards attached as attachment "D" thereto detail the specific importance of the inventive aspects of the claimed combinations as a whole of the improved-customizability digital sound relaxation and noise masking devices in accord with the present invention.

As evidenced by paragraph 17 thereof, moreover, consumer response has indicated that two (2) out of three (3) owners of digital sound relaxation and noise masking devices traded under the Tranquil Moments® marks purchase at least one collectible sound card as detailed in Attachment "E" thereto, which shows a pie chart compiled from sales data for improved-customizability digital sound relaxation and noise masking devices in accord with the present invention for the years 1996-1997.

As evidenced by paragraph 18 thereof, since the devices adapted to mate with collectable sound cards sold under the Tranquil Moments® marks in accord with the above-captioned invention are not sold with collectable sound cards, the fact that the overwhelming majority of owners of these devices go on to purchase one or more collectable sound cards, which are individually packaged and separately sold, underscores that the inventive aspects of the claimed combinations as a whole of the present invention are a principal factor motivating the commercial success of the Tranquil Moments® products in accord with the above-captioned invention.

Conclusion

For the foregoing reasons, and in view of the factual averments of the Declaration of Mr. Troy Anderson, it is respectfully submitted that the inventive aspects of the claimed combinations as a whole of the independent claims 1, 5, 10, 14, 15, and 17 of the present invention represent a non-obvious patentable advance not taught or suggested by the references of the combination rejection of record, and their reconsideration and early allowance are accordingly respectfully requested.

Since the independent claims 1, 5, 10, 14, 15, and 17 are now believed to be in allowable condition, the dependent claims 2-4, 6-9, 11, 12, 16, 18, and 19 are also in allowable condition, and need not be further discussed.

It should be noted, however, that the recited “sound bite” format of claims 8-9, 11-12 and 19 is not so indefinitely recited as to be “well-known” for which official notice is proper, but rather the recited “sound bite” format of claims 8-9, 11-12 definitely calls for at least two groups of addressable memory locations each storing different, self-contained and complete-in-themselves versions of the same sound, which, as recited in dependent claim 19, are randomly selected and played back at random times, whereby perception of annoying sound repetition is avoided and better reproduction of intermittent-type natural or other sounds then heretofore thought possible is achieved. As such, the limitations of the dependent claims 8-9, 11-12 and 19 are not believed to recite “facts outside of the record which are capable of instant and unquestionable demonstration

as being 'well-know' in the art" (MPEP 2144.03), and in view of the traversal thereof, the examiner is invited to "cite a reference in support of his or her position" (MPEP 2144.03).

For the foregoing reasons, reconsideration, reexamination and early allowance of claims 1-19 are hereby respectfully requested.

The applicants invite a telephone call to their undersigned representative to discuss any remaining question and to schedule a personal interview before the next office action in order to facilitate the further prosecution of the above-captioned invention.

Respectfully submitted,

Rudy Vandenbelt et al.

By:

A handwritten signature in black ink, appearing to be 'Albert-Peter Durigon', written over a horizontal line.

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